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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,530	12/05/2003	Michael Ganser	LWEP:104aUS	8287
24041	7590	08/23/2004	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/728,530	Applicant(s) GANSER, MICHAEL	
	Examiner Thong Q Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004 and 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/915,012.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the Request for reconsideration filed by the applicant on 7/2/2004 and the pre-amendment filed on 12/8/2003.

It is noted that the mentioned Pre-amendment has not brought into the Examiner's attention until 7/2/2004 which date is the date the Office has received the Request for reconsideration. It is also noted that the pre-amendment was filed before the date of the Office action mailed to applicant on 5/6/2004. As a result, the pre-amendment has been entered and the present Office action should be used as a substitute Office action for the Office action mailed to the applicant on 5/6/2004. The time for response to the present Office action is set to expire three months from the mailing date of this Office action.

2. Regarding to the pre-amendment of 12/10/2003, it is noted that in the mentioned pre-amendment, applicant has made amendments to the specification, the drawings and the claims as follow.

In the specification, applicant has made amendment to paragraphs [0009] and [0010] and added two new paragraphs labeled as [0021.1] and [0021.2];

In the Drawings, applicant has added two new figures labeled as figures 3 and 4 into the application; and

In the claims, applicant has canceled original claims 1-5 and added a new set of claims, i.e., claims 6-17, into the application.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/915,012, filed on 7/25/2001. 4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Drawings

5. The drawings contain four sheets of figures 1-4 were received on 12/8/2003. These drawings are entered in part for the following reasons.

The newly-filed figures 1-2 and 4 are acceptable by the Examiner; and the new figure 3 is not acceptable because it is a new matter to the application as originally filed.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature related to the arrangement of a motor or a lamp in the microscope stand as claimed in each of

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claims 6 and 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The lengthy specification which is amended by the pre-amendment of 12/8/2003 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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8. The following correction is suggested to applicant to amend the specification for the purpose of update the information of the parent application. In page 1, section [0001], the information thereof --, now U.S. Patent No. 6,717,725—should be added after “July 25, 2001”.

9. The amendment filed on 12/8/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

First, the newly-added brief description of figure 3 and the figure 3; and

Second, the description of the structure as provided in newly-added paragraph [0021.1].

Applicant is required to cancel the new matter in the reply to this Office Action.

The material as mentioned above are not supported by the original disclosure because the original disclosure has never disclosed the use of the so-called “at least one slide-in standardized circuit board” in the control and power supply unit for the purpose of control at least one motor or lamp housed in the microscope stand. Applicant should note that the paragraph [0021] in the original specification does not provide support for the mentioned structure. The original specification discloses that the control and power supply unit is housed various control units and power supply unit; however, the original specification has not disclosed that the control unit and/or power unit is in the form of a slide-in standardized circuit board.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 6-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Each of claims 6 and 12 is rejected under 35 USC 112, first paragraph because the feature related to "at least one slide-in standardized circuit board" in the control and power supply unit for the purpose of control at least one motor or lamp housed in the microscope stand is a new matter to the application as original filed. Applicant should note that the paragraph [0021] in the original specification does not provide support for the mentioned structure which is described in the newly-added paragraph [0021.1]. The original specification discloses that the control and power supply unit is housed various control units and power supply unit; however, the original specification has not disclosed that the control unit and/or power unit is in the form of a slide-in standardized circuit board.

b) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiency thereof.

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12. Claims 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Claim 10 is rejected under 35 USC 112, first paragraph because the disclosure as originally filed does not provide support for an illuminating system having an illumination unit located in a box housed a control and power supply unit, a lamp in the microscope stand and cable for guiding light from the illumination unit to the microscope stand. Applicant is respectfully invited to review the specification as originally filed in the paragraph [0021] in which the specification states that when a lamp is located in the microscope stand then a transformer is used in the box to control the operation of the lamp. The cable or light guide is not used in the embodiment which discloses the arrangement of the lamp in the microscope stand.

b) Claim 16 is rejected for the same reason as set forth in element a) above.

13. Claims 6-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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a) Each of claims 6 and 12 is rejected under 35 USC 112, first paragraph because the specification fails to provide sufficient structure and information related to the feature thereof "at least one slide-in standardized circuit board is used for controlling at least one motor or lamp housed in the microscope stand". Applicant should note that the specification has not provided any information for the so-called "slide-in standardized circuit board" as well as the connection of the slide-in circuit board to the motor or the lamp. As a result, it is entirely unclear to one skilled in the art at the time the invention was made to make the so-called "slide-in standardized circuit board" for controlling a motor or a lamp as claimed without undue experimentation.

b) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiency thereof.

14. Claims 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 10 is rejected under 35 USC 112, first paragraph because the disclosure as originally filed does not provide support for an illuminating system having an illumination unit located in a box housed a control and power supply unit, a lamp in the microscope stand and cable for guiding light from the illumination unit to the microscope stand. Applicant is respectfully invited to

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review the specification as originally filed in the paragraph [0021] in which the specification states that when a lamp is located in the microscope stand then a transformer is used in the box to control the operation of the lamp. The cable or light guide is not used in the embodiment which discloses the arrangement of the lamp in the microscope stand.

b) Claim 16 is rejected for the same reason as set forth in element a) above.

Claim Objections

15. Claim 12 is objected to because of the following informalities. Appropriate correction is required.

Claim 12 recites a control and power supply unit. See claim 3 of the claim.

However, on lines 8-9, the claim recites that the control and power supply unit further comprises a power supply. As a result, it is unclear the relationship between the power supply in the "control and power supply unit" and the power supply which is further in the "control and power unit".

Double Patenting

16. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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17. Claims 12-17, as best as understood, are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 6-11. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only difference between the claim 12 and claim 6 is the feature thereof "said at least one control and power supply unit further comprising a power supply for said microscope" recited on line 12, last two lines. However, since the "control and power supply unit" recited on line 3 of each claims 6 and 12 is understood as a unit contained control and power supply; therefore, the feature recited on last two lines of claim 12 does not further limit the subject matter of the claim 12 and as a result the structure of the device recited in claim 12 is similar to that of the device recited in claim 6.

Regarding to the features of claims 13-17, it is noted that the features of claims 13-17 are identical to those recited in claims 7-11.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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19. Claims 6-9 and 12-15, as best as understood, are rejected under 35

U.S.C. 102(b) as being anticipated by Remer et al (U.S. Patent No. 5,559,631).

Remer et al disclose an illuminating system for a microscope. The microscope comprises a stand (1). The illuminating system comprises a set of light sources (4, 5) wherein the light source (4) is housed inside the stand; a box (8) located remotely from the light source housings and the microscope stand wherein the box houses at least one power supply and control units for controlling the operation of the light sources. The box is connected to the light source housings by wire leads (13, 12) and also comprises an interface (11) which is connected to a computerized system (16) which is understood by one skilled in the art comprises keyboard or equipments for entering data to control the operation of the microscope and the illuminating system. It is clearly that the illuminating box with its own dimensions and shape as provided by Tamura et al can be used to provide illumination to different types of the microscope having a microscope stand. See columns 3-5 and fig.1.

Regarding to the so-called the control and power supply unit has at least one slide-in standard circuit board as recited in the claims 6 and 12, such a feature is a new matter to the application as originally filed. Further, the use of a dual-axis switch lever (19) for controlling the operation of the light sources is considered as a slide-in standard circuit board because the switch system as understood by one skilled in the art comprises a circuit board having circuitry connections and

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the connections between the lever and the circuitry connections are made by a sliding manner of the lever.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 6-9, 11-15 and 17, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradford et al (U.S. Patent No. 5,566,020) in view of Tsumazawa et al (U.S. Patent No. 4,862,279).

Bradford et al disclose a microscope having an illuminating system with its control support. The microscope comprises a microscope stand (27) for supporting optics (29) of the microscope and a projecting system (40) having a motor (56) for controlling the movement of a camera (52). The illuminating system and its control support as described in column 4 and shown in figures 1-2 comprises a box (18) contained power supply and control buttons wherein the box is arranged physically separate from the microscope stand. The box (18) is used to provide power to the motor (56) wherein the motor is a focusing motor. Regarding to the feature that the cable used to provide power to the motor from the box is connected to the microscope stand. However, it would have been obvious to one skilled in the art to connect the cable to the microscope stand or

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let the cable go through the microscope stand for the purpose of eliminating the disadvantage caused by the cable during a microscopic operation.

Regarding to the so-called the control and power supply unit has at least one slide-in standard circuit board as recited in the claims 6 and 12, such a feature is a new matter to the application as originally filed. It is also noted that the use of control buttons for controlling the power supply is shown by Bradford as can be seen in the figure 1. The only feature missing from the art of Bradford et al is that they do not clearly state that the control button is a slide-in button. However, the use of a switch for controlling the on-off operation of the power supply wherein the on-off operation is made by a sliding manner is known to one skilled in the art as can be seen in the system provided by Tsumazawa et al. See columns 4-5 and figs. 2b-2c. Thus, it would have been obvious to one skilled in the art at the time the invention was made to utilize a slide-in switch as suggested by Tsumazawa et al for controlling the on-off operation of a power supply

Conclusion

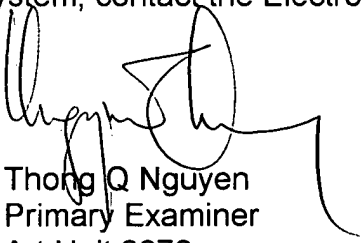
22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. It is noted that since a copy of the form PTO-1449 listed the art cited by the applicant with the Examiner's initials was mailed to applicant in the Office action of 5/6/2004; therefore, a copy of the mentioned form is not attached with this Office action. The reason is that a re-mailing of the form PTO-1449 will make the references cited in the same form PTO-1449 be printed twice on the face of the patent should this application pass to issue.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen
Primary Examiner
Art Unit 2872
